

**REMARKS****INTRODUCTION:**

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested.

Accordingly, claims 1-22 are pending and under consideration.

**REJECTION UNDER 35 U.S.C. §102:**

Claims 1, 3, 6-12, 15-17, and 21-22 stand rejected under 35 USC § 102(b) as being anticipated by Lipton et al., U.S. Patent No. 5,991,398. This rejection is respectfully traversed.

As the Office Action has indicated that Lipton et al. discloses a number of the claimed features, applicants believe a review of Lipton et al. will be helpful in noting the differences between the same and the presently claimed invention.

Lipton et al. is focused on operating a two-line telephone system with speakerphone operation, i.e., in different embodiments, Lipton et al. explains how a new phone call can be initiated on a different line while another phone call is already in progress on the other line.

In particular, Lipton et al. sets forth three particular speakerphone modes. The first speakerphone mode envisions a first phone call occurring/beginning with a speakerphone.

The second speakerphone mode envisions a first phone call occurring/beginning with a speakerphone and then a second phone call being initiated by the user by picking up the handset. This second speakerphone mode places the first phone call into a passive monitoring mode such the user can dial out and perform a second call. Here, the user can hear the first phone call but does not interact with the call.

In the third speakerphone mode, a user starts a conversation on a handset from a first line. The user can perform another phone call by activating a button or quickly depressing the hook switch, thereby switching the first phone call into a passive monitoring mode that is switched to the speakerphone output. The new phone call can then be performed through the hand set.

Thus, the primary focus of Lipton et al. is the cooperation of two input/output phone lines, a handset, and a speakerphone capability.

At no time does Lipton et al. discuss that a conversation performed through the handset

is also performed through the speaker.

In addition, there is no discussion or suggestion in Lipton et al. that any output to the speaker is dependent upon any completion of any dialing. For example, in Lipton et al., if a phone call is initiated in the speakerphone mode then the user would hear the dial tone and dialing and all communications through the completion of any dialing. Similarly, if a phone call is initiated through the handset, then the output of the speaker would not have any relationship with any dialing of that phone call.

In Lipton et al. the speakerphone is used as a way to passively monitor a first phone call, or to perform the first phone call without using the handset.

Further, it is respectfully submitted that Lipton et al. is not an enabling reference for the feature(s) potentially relied upon by the Examiner, i.e., Lipton et al. does not disclose or suggest in sufficient depth anything related to the speakerphone one-way operation being dependent on the cessation of the dialing operation. Lipton et al. does not disclose or suggest in any detail the function of turning the speaker on and off before or after a user has completed dialing to the receiving side.

Conversely, the presently claimed invention is focused on outputting the conversation that is performed in the handset also through a speaker, and particularly determines when the output of the speaker is to occur based upon the completion of a dialing.

For example, independent claim 1 sets forth

"a handset connected to the communication apparatus by a transmit-receive line, for a two-way communication operation, wherein the transmit-receive line is enabled when the handset of the communication apparatus is off-hook ;

a speaker, outputting a sound of the handset communication, to implement the one-way speakerphone operation."

Here, the speaker outputs "a sound of the handset communication."

In addition, independent claim 1 further sets forth:

"wherein a conversation signal is transmitted through the speaker *in response to the handset being off-hook, the one-way speakerphone operation selection key signal being input, and the dialing having being completed.*"

As noted above, the operation of the speaker is dependent on the handset being off-hook, the one-way speakerphone selection key, and the dialing having being completed.

Applicants set forth their discovery of a howling problem produced when a speakerphone and handset were both being used during the dialing process. To solve/avoid this howling problem, applicants have claimed the one-way operation of the speakerphone is dependent upon the ending of the dialing operation.

Conversely, in Lipton et al., when the first phone call is placed into the passive monitoring mode, to output the audio through the speaker, there is no relationship with the respective dialing of that phone call, nor any relationship with any later dialing for the later phone call.

Similarly, independent claim 3 sets forth the dependence of the completion of the dialing of the phone call to determine when to output the audio to the speaker.

In particular, independent claim 3 particularly sets forth:

"detecting whether a signal of a dial key, for a dialing of the communication apparatus, in the input key part is input within a predetermined time;

determining whether the dialing is completed; and

upon determining that the dialing has been completed, opening a line connected to a speaker of the communication apparatus and performing a one-way speakerphone operation to output a sound through the speaker during the handset conversation."

The Office Action set forth, on page 3, that "the dialing having being completed is inherently present in the speakerphone [Figs. 1-4; col. 1, line 53 to col. 2, line 18; col. 2, line 54 to col. 4, line 65]."

However, none of the cited portions of Lipton et al. disclose or suggest any relationship between the outputting of audio to the speaker based upon completion of dialing.

Conversely, in Lipton et al., the first phone call is already in existence and has no relationship with its original dialing. Similarly, the passive monitoring of the first phone call through the speaker has no relationship with any dialing for the second call.

The Office Action is presumably taking the position that some type of dialing must have been completed for the transfer of the first phone call to the speaker, so a second phone call can be completed.

However, this presumption does not take into consideration that the first phone call could have been received, i.e., without having been dialed. Further, since there is no later need or desire of knowing whether the original dialing was completed, i.e., it would be a waste of

resources to record the same, Lipton et al. would have no desire or need to perform the output of the audio to the speaker based upon the same.

In addition, it is an unreasonable interpretation of a claim feature to give the same no weight. Each claim feature has a meaning and narrows the claimed invention in some manner, i.e., each feature must be given a reasonable interpretation which does not make the same irrelevant.

To take the position that any previous phone call would inherently have been the result of a completed dialing means that this claimed dependence is irrelevant.

Conversely, the present application and the pending claims clearly evidence such dependence must be related to the initiating of the audio through the speaker, i.e., some active step is required by the claims to perform the 'determining' of whether a dialing is completed, e.g., as in claim 3. As noted above, in Lipton et al., there is no need or desire for such determination.

Thus, here, independent claim 3 particularly requires the determining of whether a dialing is completed and using that determination for deciding when to output sound through the speaker. Likewise, independent claim 6 sets forth the dependency of the output of the speaker upon completion of dialing being completed.

Again, in Lipton et al., if a first phone call is being initiated through the speakerphone, then the speaker would output all audio regardless of any completion of respective dialing. Similarly, if the first phone call is transferred to the speaker, for passive monitoring, then that outputting of audio has no relationship to its original dialing and no relationship to the dialing of the second phone call through the handset.

The Office Action relies upon the same rationale in rejecting claims 17, 21, and 22 noting that claims 17, 21, and 22 similarly require a relationship between any opening of a line connected to a speaker and a dialing of the communication apparatus. There is no such relationship in Lipton et al.

Accordingly, it is respectfully submitted that independent claims 1, 3, 6, 17, 21, and 22 are patentably distinguishable over Lipton et al. In addition, for at least similar rationale, it is respectfully submitted that claims depending from Lipton et al. are equally distinguishable.

#### REJECTION UNDER 35 U.S.C. §103:

Claims 2, 4-5, and 18-20 stand rejected under 35 USC § 103(a) as being obvious over

Lipton et al., in view of Bergen et al., U.S. Patent No. 4,536,621. This rejection is respectfully traversed.

As noted above, Lipton et al. is directed toward implementing speakerphone modes in a two-line telephone system, permitting a user to put a first call into a passive-monitoring mode so a second phone call could be placed.

Bergen et al. sets forth a method of enabling two handsets to use the same keypad to perform a dialing operation.

Initially, neither handset is enabled to perform a dialing operation through the single keypad. However, upon one dialing attempt through one handset a key entry operation is enabled for that handset for a predetermined amount of time. This enables two different handsets to use the same keypad.

The Office Action states that the claimed predetermined time period is well known, and substantiates this by referencing Bergen et al.

In particular, claim 2 sets forth:

"wherein when the dial key signal is not input within a predetermined time of the handset being off-hook and with the one-way speakerphone operation selection key signal being input, the central control device switches to an on-hook dial mode in which a user dials with the handset being on-hook, such that the conversation signal is output through the speaker for a two-way speakerphone operation,"

First, it is presumed that the Examiner's reliance on Bergen et al. in the §103 rejection means that the Examiner is not taking Official Notice of this feature, especially since the Office Action apparently is relying on Bergen et al. to provide the relied upon motivation.

Here, the Office Action has set forth that it would have been obvious to modify Lipton et al. as proffered "in order to eliminate the possibility of one use disconnecting another user's telephone line."

However, as noted above, Lipton et al. would not appear to suffer from such a problem, as only a single handset is utilized, i.e., only one user. The solution of Bergen et al. appears related to the problem of only two handsets, i.e., two users.

In addition, it would not have been obvious to modify Lipton et al., merely to have such a feature, as there is no underlying need or desire for the same. The Examiner's conclusion of a resultant benefit does not define why one skilled in the art would have made such a combination

or modification.

Thus, it is respectfully submitted that it would not have been obvious to modify Lipton et al. as proffered. Therefore, it is respectfully requested that this rejection of claims 2, 4-5, and 18-20 be withdrawn.

Claims 13-14 stand rejected under 35 USC § 103 as being obvious over Lipton et al., in view of Parks et al., U.S. Patent No. 5,977,746.

It is respectfully submitted that claims 13 and 14 are at least patentably distinguishable over the proffered combination of Lipton et al. and Parks et al., for at least the above discussion regarding Lipton et al.

#### CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

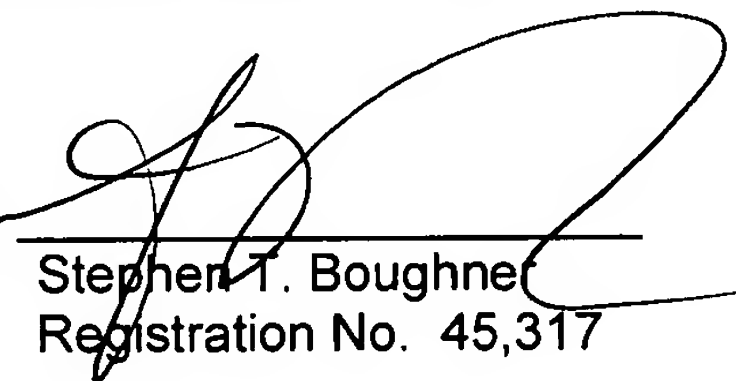
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 5/12/06

By:   
Stephen T. Boughner  
Registration No. 45,317

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501